

The opinion in support of the decision entered today was not written
for publication and is not binding precedent of the Board.

Paper No. 28

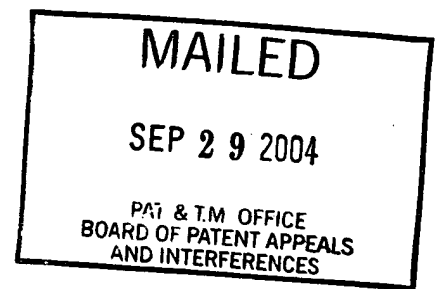
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BENJAMIN J. KWITEK

Appeal No. 2004-1279
Application No. 09/173,445

ON BRIEF



Before ABRAMS, FRANKFORT, and STAAB, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1, 3, 7-10, 14 and 21-27, all the claims currently pending in the application.

By way of background, this is the second appeal taken by appellant in this application. In the previous appeal, we affirmed the examiner's rejection of claims 1, 3, 7-10, 14 and 21-29 as being unpatentable over Minami in view of Huang and Moore. However, in response to appellant's request for rehearing of that decision, we determined "that it would have been more appropriate to reject the claims as being unpatentable over the combined teachings of Huang and Moore alone" (Paper No. 21, page 2). Hence, we granted appellant's request to reverse the examiner's rejection based on Minami, Huang and Moore, and entered a new rejection of claims 1, 3, 7-10, 14 and 21-29 as being unpatentable over Huang and Moore alone. Appellant then elected to amend the claims and have further prosecution before the examiner, which further prosecution resulted in the present appeal.

Appellant's invention pertains to a grip for an implement such as a golf club. Claim 21 is illustrative of the subject matter in issue and reads as follows (with emphasis added):

21. A grip adapted for attachment to an implement including a handle, comprising:

a longitudinally extending tubular shell including an inner surface shaped and dimensioned for attachment to the handle of the implement and an outer surface; and

a viscoelastic hand surface *having a thickness between approximately 1/16" and 1/4"* secured about the outer surface of the tubular shell, wherein the viscoelastic hand surface is a viscous liquid material contained within an elastomeric bag; and wherein the tubular shell includes a first end and a second end, and the tubular shell includes an outwardly extending first lip adjacent the first end of the tubular shell and a [sic, an] outwardly extending second lip adjacent the second end of the tubular shell, *the first and second lips being substantially the same size as the thickness of the viscoelastic hand*

surface such that the first and second lips are being¹⁾ shaped and dimensioned to retain the viscoelastic hand surface in position on the tubular shell.

The references applied in the final rejection are:

Moore et al.	5,555,584	Sep. 17, 1996
Huang	5,730,669	Mar. 24, 1998

Claims 1, 3, 7-10, 14 and 21-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Huang in view of Moore.²

Appellant's brief states on page 5 that all of the claims stand or fall together. Therefore, we have selected claim 21 as representative of the appealed claims, with 1, 3, 7-10, 14 and 22-27 standing or falling therewith.

Considering the standing rejection in relation to claim 21, in entering the new ground of rejection in our response to appellant's request for rehearing, we noted that Huang disclosed in Figure 11-14 a grip for a golf club comprising a resilient rubber-like sleeve 60 of synthetic plastic foam or rubber and a layered strip S having an open-pored felt inner layer 22 and a smooth closed pore polyurethane outer layer 26 spirally wound around the sleeve and adhered thereto. We observed that the sleeve 60 included a raised shoulder portion in the form of a cap 62 at one end and a raised shoulder portion in the form of a guide cylinder 64 at the other end, and that strip was spirally wound around the

¹It appears that the word "being" here should be deleted.

²The examiner notes on page 3 of the answer that the copy of claim 14 in the appendix to appellant's brief is incorrect.

sleeve in the area defined between the raised shoulder portions. We further noted that Moore, in pertinent part, disclosed a custom fit hand grip for a sports racket such as a tennis racket or golf club, and that the Moore grip comprised a gel material, for example, an uncured silicon rubber, encased in an airtight elastomeric envelope 59, 64.

Based on the above teachings, we concluded that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to replace the strip-like grip element S of Huang's Figures 11-14 replacement grip with a custom fit grip element like that disclosed in Moore in order to derive the benefits disclosed in Moore that such custom fit grip elements provide, namely, greater user comfort and more even distribution of pressure. In so doing, we concluded that the relationship between the grip element and the lips of the modified Huang replacement grip would be such that the depth as defined by the first and second lips would be substantially the same as the thickness of the hand surface to retain the hand surface in position on the tubular shell, as called for in claim 21. We also concluded that the requirement of dependent claim 29 that the viscoelastic hand surface has a thickness between approximately 1/16" and 1/4" would have been obvious to one of ordinary skill in the art, noting in this regard Moore's disclosure at column 10, lines 55-64, that the gel material thereof can be rolled into sheets 1/8 to 1/4 inch thick and sealed in an envelope.

Appellant argues in response to the new rejection that the claimed subject matter as a whole would not have been obvious to one of ordinary skill in the art in view of the teachings of the applied references. More specifically, appellant concedes that Moore discloses that the gel material may be rolled into sheets 1/8" (3.17 mm) to 1/4" (6.35 mm) thick (Moore, column 10, lines 61-63), which would result in a grip element within the thickness range of approximately 1/16" (1.59 mm) and 1/4" (6.35 mm) set forth in the claims for the hand surface. Appellant notes, however, that Huang discloses a grip element having an overall thickness of about 1.3 millimeters³, which is outside the claimed range, with the outwardly extending cap 62 and guide cylinder 64 of Huang's tubular sleeve being approximately the same 1.3 millimeter thickness. Based on these disclosures, appellant concludes (brief, pages 9-10):

Application of the gel material of Moore to the sleeve disclosed by Huang as proposed in accordance with the outstanding rejection, would result in an entirely unworkable grip with the gel material overhanging the cap 62 and guide cylinder 64 disclosed by Huang. The overhanging gel material would be cumbersome to grip and the likelihood the gel material would slip relative to the sleeve 60 is very great given the lack of reinforcement to either the top or the bottom of the gel material.

. . . Without such supports, the gel material will certainly flow during use, moving the racket relative to the hand of the user in a very undesirable manner.

³Huang discloses at column 4, lines 61-65, that the polyurethane outer layer may have a thickness of about 0.4 millimeters and that the felt inner layer may have a thickness of about 0.9 millimeters.

This movement is exactly the likely result when the gel material is applied to the grip structure disclosed by Huang. As nothing in the cited prior art suggests the need for retaining a gel material when utilized as a hand surface for a golf grip . . . any proposition for increasing the thickness of the cap 62 and guide cylinder 64 to provide a retaining system for the gel material is entirely unsupported by the prior art and it would not be obvious to increase the thickness of the cap 62 and cylinder 64 so as to accommodate the increase thickness of the grip disclosed by Moore.

Thus, appellant asserts (brief, page 11) that nothing in the cited prior art discloses or suggests the claimed thickness relationship between the viscoelastic hand surface and the first and second lips, or the retaining function of the lips so that they act to retain the viscoelastic hand surface in position.

The test for obviousness is not whether the features of the secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Moreover, in combining prior art teachings, the artisan is not compelled to blindly follow the teachings of one prior art reference over the other without the exercise of independent judgement (*Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 889, 221 USPQ 1025, 1032 (Fed. Cir. 1984).

Appellant's argument is not persuasive for a number of reasons. First, the thicknesses for the polyurethane outer layer and felt inner layer set forth in Huang at column 4, lines 61-65, are not hard and fast thicknesses, but rather merely preferred

thicknesses. See column 4, line 63. Hence, there is nothing in Huang which limits the thickness of the wrapped layer S, and the depth of the recessed area between the cap 62 and guide cylinder 64, to 1.3 millimeter thickness, as appellant would apparently have us believe.

Second, we do not agree with appellant's assessment of the prior art (brief, pages 10-11) as failing to disclose a retaining function for the cap 62 and guide cylinder 64 of Huang. While we acknowledge that Huang does not provide an express statement of the function of these sleeve elements, we consider that the operation of cap 62 and guide cylinder 64 to define the limits of the grip region and retain the layered strip S in position is inherent in Huang's disclosure, and that one of ordinary skill in the art would have reasonably inferred as much based on, among other things, the structural relationship of the sleeve elements and the strip, and Huang's objectives (column 6, lines 41-49) of preventing unraveling of the hand surface for the sleeve and reducing interference with other golf club grips when a golf club is removed from a golf bag. In this regard, in considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

Third, appellant's argument is based on bodily incorporating the gel material grip of Moore, the secondary reference, into the grip structure of Huang, the primary reference; however, this is not the test for obviousness. *In re Keller, supra*. When the combined teachings of the references are considered in their entirety, we believe the ordinarily skilled artisan would have understood that the relationship between the thickness of the hand surface and the depth of the cap and guide cylinder in Huang contributes to the realization of Huang's objectives of preventing unraveling of the hand surface for the sleeve, providing a pleasing appearance, and reducing interference with other golf club grips when a golf club is removed from a golf bag so as to reduce wear and tear on the grips (Huang, column 6, lines 41-49). Assuming skill in the art, rather than the converse, (*In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985)), we consider that the ordinarily skilled artisan would have appreciated that in modifying Huang's grip surface, the thickness of the grip surface should match the depth of the cap and guide cylinder in order to achieve Huang's above noted objectives. Appellant's opposing view fails to take into consideration what the combined teachings of the applied references would have suggested to one of ordinary skill in the art.

In light of the foregoing, we shall sustain the rejection of claim 21 as being unpatentable over Huang in view of Moore. We shall also sustain the rejection of claims 1, 3, 7-10, 14 and 22-27 as being unpatentable over Huang in view of Moore since, as

The decision of the examiner is affirmed.

AFFIRMED

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) AND
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